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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,770	02/22/2002	Lucas S. Gordon	24021-501	2720

7590 09/21/2005

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EXAMINER	
LACYK, JOHN P	

ART UNIT	PAPER NUMBER
3736	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/081,770	GORDON, LUCAS S.	
	Examiner	Art Unit	
	John P. Lacyk	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-21 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-2, 6-7 and 11 rejected under 35 U.S.C. 102(e) as being anticipated by Jordan.

Jordan discloses a stent that has a ferromagnetic material that has an external magnetic field applied to it. With regard to claim 11 since the device is made from a ferromagnetic material and has an external magnetic field applied to it, the examiner's position is that it would inherently remain magnetized after removal of the magnetic field as per claim 11.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jordan in view of Hyodoh et al.

Jordan, as discussed above, teaches a stent that has a ferromagnetic material that is subject to an external magnetic field. Jordan fails to teach that the stent includes a shape memory material. Hyodoh et al discloses a stent that includes a shape memory material (paragraphs 0022-0027). Therefore a modification of Jordan to include a shape memory material would have been obvious in view of Hyodoh et al since Hyodoh et al teaches that it is well known to include such a material in stents.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jordan in view of Krebs, Jr.

Jordan, as discussed above, discloses a stent having ferromagnetic material that is magnetized by an external magnetic field. Krebs, Jr. discloses a teaching that it is well known to demagnetize an object using a degaussing coil. While the claim is directed to a functional implant and the only structural limitations claimed of the implant is comprising a ferromagnetic material, Jordan is considered to meet the limitations of the claim. However as can be seen by the teaching of Krebs, Jr. it is well known to demagnetize objects, therefore a modification of the Jordan device such that the implant is demagnetized by a degaussing device when the treatment is completed would have been obvious to one skilled in the art since the ability to demagnetize objects is well known.

6. Claims 3, 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Weissleder et al.

Weissleder et al discloses a functional implant or stent (column 10, lines 40-46) that includes a superparamagnetic material. Weissleder et al teaches a biocompatible polymer matrix that can include a superparamagnetic material.

7. Claims 13, 18 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen et al.

Chen et al discloses a "functional" implant (as stated in applicant's disclosure a "functional implant" is considered to be any device that is placed in a patient's body, which this clearly is, and which has a primary function, in this case providing photodynamic therapy, that does not inherently require magnetism for its use, photodynamic therapy previously provided a photoreactive agent without the use of magnets thereby not inherently requiring magnetism for its use) having a magnetic field and a medical agent carried by a magnetically sensitive carrier such that the agent migrates to the magnetic field emitted from the implant to substantially localize the agent around the implant.

8. Claims 14-17, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al in view of Jordan, Weissleder et al and Krebs, Jr.

Chen et al discloses the claimed device and method except for specifically using a ferromagnetic or superparamagnetic material to provide the magnetic field around the implant or to specifically demagnetize the device when not wanted. As discussed above, Jordan and Weissleder et al show that it is well known to use such materials to provide a magnetic field in the body. Therefore a modification of Chen et al such that the magnet of Chen et al is substituted with any known material used in the body to provide a magnetic field would have been obvious since this would merely have been a substitution of known materials based upon the suitability for the intended use. Further to demagnetize the device would have been obvious in view of Krebs, Jr. for the same reasons as discussed above.

9. Applicant is also requested to submit the Russian patents and the article discussed on page 5 of the specification in that they seem to be relevant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Lacyk whose telephone number is 571-272-4728. The examiner can normally be reached on Mon-Fri, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John P Lacyk
Primary Examiner
Art Unit 3736

J.P. Lacyk